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MF

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/874,450	06/05/01	ALLPORT	D 239/008-C1

023410
NEAL M COHEN
2424 SE BRISTOL STREET
SUITE 300
NEWPORT BEACH CA 92660

WM01/0913

EXAMINER

NGUYEN, J

ART UNIT

PAPER NUMBER

2673

DATE MAILED: 09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/874,450

Applicant(s)

ALLPORT, DAVID E.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed limitations, "set-top box" in claims 10 and 32, "Internet" in claim 16, "port" in claim 25, "a database" and "a separate storage device" in claim 26, "a banner ad program" in claim 30, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Objections

2. Claim 6 is objected to because of the following informalities: line 2, "date" should be changed to -- data --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-26, 32 and 38-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 1-26 and 38-44, the pending application and the parent application (S/N: 09/280,524), both do not disclose the claimed limitation, "a current system state of the controller related to the a previous system state of the controller", as recited in independent claims 1, 17 and 38. The specification only discloses "a system state the same as or similar to the system

state the controller was in the last time the user had control thereof”, page 13, lines 7-10.

Therefore, this claim is rejected for the reason as set forth above.

It is suggested that the word “related” should be changed to -- similar --or -- identical-- to be consistent with the specification.

Further, as per claim 6, the pending application and the parent application (S/N: 09/280,524), both do not disclose the claimed limitation, “the voice data is received after the controller enters a temporary system state in response to a request to process the voice data”, as recited in the claim. Therefore, this claim is rejected for the reason as set forth above.

Further, as per claims 10 and 32, the pending application and the parent application (S/N: 09/280,524), both do not disclose the claimed limitation, “set-top box”, as recited in claims 10 and 32. Therefore, these claims are rejected for the reason as set forth above.

5. Claims 15, 16, 24, 28-31, 34, 35, 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 15, 24 and 28, the specification does not disclose or teach how the current system state prevents use of the controller for accessing pay-per-view programming. Therefore, theses claims are rejected for the reason as set forth above.

As per claims 16 and 29, the specification does not disclose or teach how the current system state allows use of the controller for conducting e-commerce transactions via the Internet. Therefore, theses claims are rejected for the reason as set forth above.

As per claims 30 and 31, the specification does not disclose or teach how the second system state causes a banner ad program to execute and display a banner ad on a display associated with the controller, as recited in claim 30. Therefore, these claims are rejected for the reason as set forth above.

As per claims 34 and 43, the specification does not disclose or teach how to switch to a second system state from the first system state at a time calculated by an algorithm which incorporates a category of use associated with the consumer device. Therefore, these claims are rejected for the reason as set forth above.

As per claims 35 and 44, the specification does not disclose or teach how to switch to a second system state from the first system state at a time calculated by an algorithm which incorporates a subject matter of activity within a category of use associated with the consumer device. Therefore, these claims are rejected for the reason as set forth above.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-9, 11-14, 17-23, 27, 33-35 and 37-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S.

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Patent No. 6,256,019 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a handheld controller including a bio-metric user identification input component such as a fingerprint pad or a microphone and a display, and an associate method of controlling multi-user access to functionality of consumer device such as a television. Therefore, these claims are rejected for the reason as set forth above.

8. Claims 10, 15, 16, 24-26, 28-32 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,256,019 B1 in view of Merjanian (USPN: 5,920,642, cited in IDS). The patent claimed the same subject matter except for the consumer device being a set-top box, the current system state preventing the controller for accessing pay-per-view programming, the bio-metric input component being connected to the controller via a port on the controller, a database of known users of the controller stored externally to the controller on a separate storage device and the second set of functionality being different than the first set of functionality, as recited in these claims above. However, Merjanian discloses a related controller, wherein the consumer device is a set-top box (col. 3, line 28), the controller has a capable to prevent accessing pay-per-view programming (col. 3, lines 39-47), the bio-metric input component is connected to the controller via a port on the controller (see fig. 1), a database of known users of the controller stored externally to the controller on a separate storage device (col. 3, lines 47-51), and the second set of functionality is different than the first set of functionality (col. 3, lines 47-51). Therefore, it

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would have been obvious to one skilled in the art to obtain the invention as specified in claims above.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422.

The examiner can normally be reached on Tuesday - Friday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at (703) 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

JHN

September 7, 2001